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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/802,503	03/16/2004	Thaddeus R. Nieduzak	05487	3675

5487 7590 11/01/2004  
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EXAMINER

WU, SHEAN CHIU

ART UNIT	PAPER NUMBER
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1756

DATE MAILED: 11/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/802,503	<b>Applicant(s)</b> NIEDUZAK ET AL. <span style="float: right;">21</span>	
	<b>Examiner</b> Shean C. Wu	<b>Art Unit</b> 1756	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 4-11 and 15-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 12-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-18 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. This is a continuation of application serial 10/410,485, which is a continuation of 10/177,996, now abandoned, which is a continuation of 09/575,023, now abandoned, which is a continuation of 08/833,811, now abandoned, which is a continuation of 08/749,387, now abandoned, which is a continuation of 08/569,834, now abandoned, which is a continuation of 08/464,985, now abandoned, which is a division of 08/341,857, now abandoned, which is a continuation of 08/022,502, now abandoned, which is a continuation-in-part of 07/872,566, now abandoned. The claims 4-11 and 15-18 have been canceled and claims 1-3 and 12-14 are pending.

2. Claims 13 and 14 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 13 and 14 are depending on canceled claim 11.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bush et al. or Antoku et al (U.S. 4,948,799).

Bush's teaching has been set forth in the office action mailed 1/24/95 (paper No. 13 of 08/341,857) and the rejection is repeated for the reasons of record. Also, see table 7 of the '799.

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As stated in the prior office action, the positional isomer of the reference compound is unpatentable as *prima facie* obvious to those skilled in the art, unless it possesses some new, unobvious or unexpected and unobvious results (e.g., properties and/or utilities) presented.

5. Claims 1 and 12-14 are rejected under 35 U.S.C. § 103 as being unpatentable over WO 9,313,083.

The reference discloses a compound represented by the formula RN 151097-64-2 (see attached abstract). The reference compound differs from the claims in that the claims have an additional methylene group attached to piperidinyl ring. Since a homologous and similarity of the reference compound and the present compound, it would be *prima facie* obviousness to those skilled in the art.

6. Claims 1-3 and 12-14 are rejected under 35 U.S.C. § 103 as being unpatentable over Bush et al. or Antoku et al (U.S. 4,948,799) in view of Carr et al. (U.S. 5,292,752).

Bush et al. and Antoku teachings have been set forth in the section 8. The reference differs from the claims in that the claims have a different orientation of the 4-piperidyl-N-methylene function. Carr discloses an exact orientation of the present invention (see formula II on col. 5 of the '752). Since the orientation of the piperidinyl of the '752 is useful as an antithrobotic agent and as a serotonin 5HT<sub>2</sub> antagonist, it would have been obvious to those skilled in the art to utilize the formula II of the '752 to Bush or Antoku to arrive at the claimed invention.

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7. Claims 1 and 12-14 are rejected under 35 U.S.C. § 103 as being unpatentable over WO 9,313,083 in view of Carr et al. (U.S. 5,292,752).

The reference discloses a compound represented by the formula RN 151097-64-2 (see attached abstract). The reference compound differs from the claims in that the claims have an additional methylene group attached to piperidinyl ring. Carr discloses an exact orientation of the present invention (see formula II on col. 5 of the '752). Since the orientation of the piperidinyl of the '752 is useful as an antithrobotic agent and as a serotonin 5HT<sub>2</sub> antagonist, it would have been obvious to those skilled in the art to utilize the formula II of the '752 to WO '083 to arrive at the claimed invention.

8. This is a continuation patent application of applicant's 10/410,485. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicants are reminded of the extension of time policy as set forth in 37 CAR 1.136(a).

A shortened statutory period for response to this final action is set to expire THREE

MONTHS from the date of this action. In the event a first response is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CAR 1.136(a) will be calculated from the mailing date of the


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advisory action. In no event will the statutory period for response expire later than SIX MONTHS from the date of this final action.

9. The cited references in pto-892 form have been furnished in application 08/833,811.
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shean C. Wu whose telephone number is 571-272-1393. The examiner can normally be reached on 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Shean C Wu  
Primary Examiner  
Art Unit 1756

SCW